

REMARKS

Please consider the foregoing amendments and the following remarks in response to the Office Action mailed December 14, 2007.

The claims have been amended to narrow the issues and place them in better form for appeal. Consideration and entry of the amendments is respectfully requested. Applicants, however, respectfully request withdrawal of the finality of the rejection. New references were applied in the December 14 Office Action. According to the Action, the applicants' prior amendment necessitated the new grounds of rejection and the Action accordingly was made final. The prior amendment was the recitation of "floor" in the description of the claimed surface coverings. But original dependent claim 20 was drawn to "a conductive and antistatic flooring" and the original specification only described new floor surface coverings. In fact, the Field of the Invention on the first page of the specification says, "The invention relates to an electrically conductive floor covering." Effectively, applicants' original claims were drawn to flooring and would have been interpreted as such even if "floor" was not recited in the claims.

Applicants understand the rules no longer give to an applicant the right to amend as often as the examiner presents new references or reasons for rejection. But according to the Manual of Patent Examining Procedure, "present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application." M.P.E.P. § 176.07 (8th Edition, incorporating revision No. 6).

To say the added recitation of the word "floor" in the claims of an application clearly having to do with floor surface covering necessitated a new search and therefore a final rejection is unfair to the applicant and will ultimately create unnecessary work for the examiner and the Board of Appeals. Applicants submit that the claims presented with the present amendment are allowable. Clarifying amendments have been made and the language of the claims has been modified to make them more consistent with one another. Independent claim 12 has been amended to incorporate dependent claims 14 and 22 and to incorporate additional elements from the detailed description in the specification, i.e., that the top coating must be transparent and the particles incorporated in the top coating are substantially spherical glass particles. New independent claims 25 and 26 of diminishing scope have also been added and the informality in claim 21 has been corrected. Withdrawal of the finality of the rejection and examination of the presently amended claims is respectfully requested.

Claims 12-13, 15-18 and 23-24 have been rejected under 35 U.S.C. §102(b) as being anticipated by Hari et al. And claims 14 and 22 have been rejected as being unpatentable over Hari et al. under 35 U.S.C. §103(a). Since claims 14 and 22 have been canceled and the subject matter has been incorporated in claim 12 and new independent claim 25 and 26, we shall respond to the §102(b) and §103(a) rejections together.

Hari does not disclose or suggest a transparent top coating. Hari does not disclose or suggest incorporating substantially spherical glass particles in a top coating. And Hari does not disclose or suggest coating such particles with a conductive coating

comprised of silver, aluminum, copper, nickel, gold, or an alloy thereof with another metal. Therefore the §102(b) rejection must be withdrawn.

Turning to §103(a), Hari employs amorphous or spheroidal graphite and/or carbon fibers and/or finally divided metal. None of these materials are employed as particles in applicants' pending claims. Hari is not concerned about making a transparent top coating, a very important feature of applicants' invention because it allows the decorative substrate beneath the top coating to show through. Hari's invention is concerned only with conductivity and as such he uses conductive materials that are not employed by applicants. There is no disclosure in Hari that would teach or suggest to one skilled in the art that metal coated glass beads could be used to make a transparent conductive top coating for a flooring substrate. Applicants accordingly respectfully request withdrawal of the §102 and §103 rejections over Hari.

Claims 19-21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Hari et al. and further in view Wienand et al. Wienand is applied to claims 19-21 as teaching an anti-static or electrically conductive floor covering having a conductive top layer of a few tenths of a millimeter and for teaching a substrate of polyvinyl chloride resin (PVC) having vertical holes filled with conductive paste to produce vertical conductive channels. But the construction disclosed by Wienand is completely different from the construction claimed by applicants. Wienand fills holes in a substrate with a conductive paste and then coats one side of the substrate with the conductive paste. Alternatively, Wienand coats both sides of a substrate with conductive paste and then cuts the substrate along a plane parallel to the upper and lower surfaces. (See Fig. 5, line A-A and specification at col. 3., ln. 22-35.) In all

embodiments of Weinand, the coated surface of the substrate is on the underside. The coated surface is not a top coating. Applicants employ glass spheres coated with a conductive layer and mix them with a dispersion of a topcoat material. Then this mixture is coated onto a substrate as a top coating. There is nothing about Wienand that would make applicants' product obvious because Weinand's construction is completely different from applicants' construction. Furthermore, the primary reference in this rejection, Hari et al., has been distinguished above in respect of the claims from which claims 19-21 depend. Accordingly, claims 19-21 are also allowable because they depend from allowable claims. Withdrawal of the §103 rejection over Hari in view of Wienand is respectfully requested.

Claims 12, 13, 15, 16, 17, 20 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Heckel et al. or Szerreiks et al. in view of Kojimoto.

Heckel relies upon apertures in an top layer which provide electrical conductivity to a conductive bottom layer which contains from about 3% to about 80% by weight carbon black or graphite. The top layer of Heckel may contain a small amount of graphite but the layer is not transparent. In fact, Heckel states in his abstract "the dark color of the bottom layer resulting from its carbon black or graphite content therefore need not significantly affect the appearance the top layer". Thus, the top layer of Heckel is used to hide or obscure the underlayer. It is not transparent as presently claimed by applicants. Accordingly, Heckel is not a viable reference against applicants' claims.

Szerreiks describes a linoleum product having a linoleum wear layer as the visible surface in the installed floor covering. (See Szerreiks, col. 2, ln. 63-65 and col.

3, In. 41-43.) Carbon black and metal powder are used as the conductive material and the wear layer is colored or patterned. (See Szerreiks, col. 3, In. 61-67.) The wear layer of Szerreiks is not transparent and it does not contain metal coated glass spheres.

Neither Heckel nor Szerreiks teach or suggest a transparent conductive top coating and neither reference teaches or suggests the use of metal coated glass beads to make a transparent conductive top coating. Kojimoto cannot overcome the deficiencies of the primary references by teaching the use of graphite having a particle size of 5-150 micron in an electrically conductive floor covering. No prima facie case of obviousness exists because none of the references teach or suggest a transparent conductive top coating and none of the references teach or suggest a transparent conductive top coating employing metal coated glass beads. Withdrawal of the rejection is respectfully requested.

Conclusion

The instant application is believed to be in condition for allowance. A Notice of Allowance of claims 12, 15-21 and 23-26 is respectfully requested. The Examiner is invited to telephone the undersigned at (908) 722-0700 if it is believed that further discussions, and/or additional amendment would help advance the prosecution of the instant application.

If any extension of time for this response is required, applicants request that this be considered a petition therefor. Please charge any required petition fee to Deposit Account No. 14-1263.

Please charge any insufficiency of fees, or credit any excess, to Deposit Account

No. 14-1263.

Respectfully submitted,

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